

Application No. 10/002,573
Amendment Dated February 7, 2006
In reply to Office Action dated November 16, 2005

REMARKS:**Status Of Claims**

Claims 37-44 were previously pending. Claim 41 has been amended. Claims 47-55 have been added. Thus, claims 37-44 and 47-55 are currently pending in the application with claims 37, 40, and 41 being independent.

Office Action

In the Office Action, the Examiner rejected claims 37, 38, and 40-44 under 35 U.S.C. § 103(a) as being unpatentable over Sprague et al., U.S. Patent No. 5,422,816, in view of Marcarelli et al., U.S. Patent Application Publication No. 2002/0070881. The Examiner also rejected claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Sprague in view of Marcarelli in further view of Tanchina et al., U.S. Patent Application Publication No. 2003/0080897. Applicant respectfully submits that the currently pending claims distinguish the present invention from Sprague, Marcarelli, Tanchina, and the other prior art references of record, taken alone or in combination with each other.

Specifically, claim 37 recites "an auxiliary coding system that, when enabled, codes all location data transmitted by the transceiver so that the location data can only be decoded by other radios having a similar auxiliary coding system". Claim 40 recites "coding the location data with a coding system so that the location data can only be decoded by radios having a similar coding system".

In contrast, on page 2 of the Office Action, the Examiner acknowledges that

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"Sprague et al. fail[s] to disclose coding and decoding location data". However, the Examiner improperly combines Sprague with Marcarrelli as teaching this limitation.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP § 2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

Specifically, the Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) *the prior art reference (or*

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combination of references) must teach or suggest all the claim limitations. MPEP

§706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 1442 (Fed. Cir. 1991). Thus, measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Additionally, "the mere possibility that one [element] could be modified or replaced ... does not make the [claim] obvious 'unless the prior art suggested the desirability of [such a] modification' or replacement". *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1995) (citing *In re Gordon*). Finally, "if the proposed modification would render the prior art invention being

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modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

In the present case, there is simply no suggestion or motivation to combine Sprague with Marcarrelli. Specifically, for example, the motivation for Sprague's invention is that "[m]any business, technical and military organizations could benefit from an automatic method of collecting the position of each individual remote station and any base station and by the distributing of such meter network positions to *all*", emphasis added. Sprague, column 1, lines 19-23. In other words, the whole point of Sprague is to share location data with everyone on the network, and therefore explicitly teaches away from encoding location data. Furthermore, encoding location data would render Sprague unsatisfactory for its intended purpose of "distributing ... positions to all". *Id.* Therefore, there can be "no suggestion or motivation to make the proposed modification." MPEP §2143.01. As a result, the Examiner has not met the burden of establishing a *prima facie* case of obviousness, and therefore the present rejections simply cannot be sustained.

Claim 41 recites "the CTCSS further including an emergency CTCSS tone that, when selected and transmitted, enables the audio output of the other radio whether or not the other radio has been set to the same CTCSS tone as the radio".

In contrast, on page 4 of the Office Action, the Examiner acknowledges that "Sprague et al. fail[s] to disclose an emergency tone". However, the Examiner improperly combines Sprague with Marcarrelli as teaching this limitation. While Marcarrelli does appear to teach "an emergency signal transmission feature", he fails to discuss any

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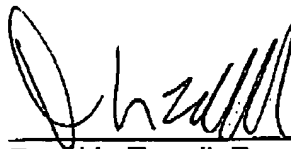
CTCSS, and therefore Marcarelli's emergency signal is simply not disclosed to have any impact on a CTCSS, much less enabling "the audio output of the other radio whether or not the other radio has been set to the same CTCSS tone as the radio", as claimed in claim 41. Finally, as discussed above, there can be "no suggestion or motivation to make the proposed modification." MPEP §2143.01. As a result, the Examiner has not met the burden of establishing a *prima facie* case of obviousness, and therefore the present rejections simply cannot be sustained.

Claims 47-55 have been added to further distinguish the present invention over the prior art. The remaining claims depend from claims 37, 40, or 41, and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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